

PATENT
Attorney Docket No. 7198
Client Reference No. 066548-0133

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

RONALD A. BRACO

Art Unit: 3692

Application No.: 09/852,119

Examiner: OJO O. OYEBISI

Filed: May 9, 2001

For: Electronic Bill Presentment
and Payment System

APPELLANT'S APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of an appeal from the rejection dated April 18, 2007, and the Notice of Appeal filed on July 12, 2007, Appellant now submits this Appeal Brief.

INDEX

Section	Page No.
<i>Real Party In Interest</i>	3
<i>Related Appeals and Interferences</i>	3
<i>Status of Claims</i>	3
<i>Status of Amendments</i>	3
<i>Summary of Claimed Subject Matter</i>	3
<i>Grounds of Rejection to be Reviewed on Appeal</i>	9
<i>Argument</i>	9
<i>Claims Appendix</i>	29
<i>Evidence Appendix</i>	36
<i>Related Proceedings Appendix</i>	37

Real Party In Interest

The patent application that is the subject of this appeal is assigned to Metavante Corporation, Milwaukee, Wisconsin 53223.

Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

Status of Claims

Claims 1-26 and 31-34 were rejected in the Office Action mailed on April 18, 2007 and are on appeal.

Status of Amendments

The last amendment in this application was filed on January 29, 2007. The amendment was entered upon filing of the RCE.

Summary of Claimed Subject Matter

The present application is directed to electronic systems for bill presentment and payment. No claim elements in the independent claims of this application are in means plus function or step plus function format.

Claim 1

Claim 1 recites a switching system for electronic bill presentment and payment (BPP) of bills over a network. The subject matter of this claim includes a first consumer service provider device in electronic communication with a first consumer terminal and a first biller service provider device in electronic communication with a first biller terminal. Claim 1 also

recites a second consumer terminal and a second biller terminal. These claim limitations are described at least in the specification at p. 5, line 29 to p. 6, line 2 and are depicted in FIGS. 1 and 2 as elements 105 (biller terminal), 110 (biller service provider), 120 (consumer service provider device), and 125 (consumer terminal).

Claim 1 also recites a switching network which is in electronic communication with said first consumer service provider device using one of a first message standard protocol and a second message standard protocol, with said first bill service provider device using one of said first and second message standard protocols, with said second consumer terminal using one of said first and second message standard protocols, and with said second biller terminal using one of said first and second message standard protocols, routing presentment information between said first consumer service provider or said second consumer terminal and said first bill service provider or said second biller terminal, said switching network being a multi-standard switch configured to facilitate electronic communication between said first consumer service provider or said second consumer terminal and said first bill service provider and said second biller terminal irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use. Support for this claim limitation is found at least in the specification at p. 6, lines 12-25 and p. 9, lines 4-8. The passage on p. 6 states that the system is flexible in that each participant may use its own system and participants need not use the same message standard in order to exchange information. An example is stated of a consumer service provider using an OFX message protocol standard and exchange information with a biller service provider that employs an IFX message protocol standard.

Thus, each limitation of Claim 1 is fully supported in the application as filed.

Claim 9

The limitations of independent Claim 9 are also fully supported in the application as filed. Claim 9 has many of the elements of Claim 1 in that claim 9 includes a consumer terminal and a biller terminal. As previously indicated, support for these elements is at least in the specification at p. 5, line 29 to p. 6, line 2 and are depicted in FIGS. 1 and 2 as elements 105 (biller terminal) and 125 (consumer terminal).

Claim 9 also requires a switching network which is in electronic communication with said consumer terminal using one of a first message standard protocol and a second message standard protocol and with said biller terminal using one of said first and second message protocols, exchanging billing information between said consumer terminal and said biller terminal irrespective of which message protocol each of said consumer terminal and said biller terminal use. Support for this claim limitation is found at least in the specification at p. 6, lines 12-25, and p. 9, lines 4-8. The passage on p. 6 states that the system is flexible in that each participant may use its own system and participants need not use the same message standard in order to exchange information. An example is stated of a consumer service provider using an OFX message protocol standard and exchange information with a biller service provider that employs an IFX message protocol standard.

Claim 9 also requires that said switching network route bill summary data generated by said biller terminal for presentation at said consumer terminal, the complete bill data being accessible only by direct communications between said consumer terminal and said biller terminal. Support for this claim limitation is found at least in the specification at p. 9, lines 15-30 and in FIG. 4. In FIG. 1, element 195 represents direct communications between a consumer terminal and a biller terminal.

Thus, the application supports the Claim 9 limitations of a switching system as recited in the claim.

Claim 17

Claim 17 recites a method for electronic presentment and payment of bills over a network. The subject matter of this claim includes providing a switching network for facilitating electronic presentment and payment of bills. Support for this claim limitation is found at least in the specification at p. 6, lines 12-25 and FIGS. 1-3 (switching network 115).

Claim 17 further requires establishing electronic communication between the switching network and first and second biller terminals and first and second consumer terminals, the switching network being a multi-standard switch configured to communicate with said first and second biller terminals and said first and second consumer terminals in either of at least first and second message standard protocols, said switching network communicating with at least one of said first and second biller terminals and said first and second consumer terminals using said first message standard protocol and at least one of said first and second biller terminals and said first and second consumer terminals using said second message standard protocol. Support for this claim limitation is found at least in the specification at p. 5, lines 13-30 and p. 6, lines 12-25. The passage on p. 6 states that the system is flexible in that each participant may use its own system and participants need not use the same message standard in order to exchange information. An example is stated of a consumer service provider using an OFX message protocol standard and exchange information with a biller service provider that employs an IFX message protocol standard.

Claim 17 also requires the steps of generating bill summary data from complete bill data provided by each of said first and second billing terminals and selectively routing

portions of said bill summary data via the switching network to present appropriate portions of said bill summary data to said first and second consumer billing terminals. Support for these limitations is found at least in the specification at p. 9, lines 9-30 and in FIG. 4.

Thus, the application supports the limitations of claim 17 as recited in the claim.

Claim 25

Claim 25 recites a switching system for electronic bill presentment and payment (BPP) of bills over a network and recites many of the same elements as claim 1. Specifically, a first consumer terminal, a second consumer terminal, a first biller terminal, and a second biller terminal are recited. These claim limitations are described at least in the specification at p. 5, line 29 to p. 6, line 2 and are depicted in FIGS. 1 and 2 as elements 105 (biller terminal) and 125 (consumer terminal).

Claim 25 further requires a switching network in electronic communication with said first and second consumer terminals and said first and second biller terminals, said switching network for routing presentment information from said first and second biller terminals to said first and second consumer terminals and payment information from said first and second consumer terminals and said first and second biller terminals, said switching network being a multi-standard switch configured to communicate with said first and second consumer terminals and said first and second biller terminals in either of first and second message standard protocols. Support for this claim limitation is found at least in the specification at p. 5, lines 13-30 and p. 6, lines 12-25.

Claim 25 also requires that the switching network communicate with at least one of said first and second consumer terminals and said first and second biller terminals using said first message standard protocol and at least one of said first and second consumer terminals

and said first and second biller terminals using said second message standard protocol.

Support for this claim limitation is found at least in the specification at p. 5, lines 13-30 and p. 6, lines 12-25. The passage on p. 6 states that the system is flexible in that each participant may use its own system and participants need not use the same message standard in order to exchange information. An example is stated of a consumer service provider using an OFX message protocol and exchange information with a biller service provider that employs an IFX message protocol.

Thus, the application supports the limitations of claim 25.

Claim 26

Claim 26 recites a system for electronic presentment and payment of bills over a network. The subject matter of this claim includes a consumer terminal and a biller terminal in communication with the consumer terminal. Support for these claim limitations is found at least in the specification at p. 6, lines 26-30 and in FIGS. 1-3 as biller terminal 105 and consumer terminal 125.

Claim 26 also requires a switching network for routing a payment message for a particular bill between said consumer terminal and biller terminal, irrespective of whether the particular bill has been previously presented to said consumer terminal. Support for this claim limitation is found at least in the specification at p.10, lines 3-30 and p. 11, lines 5-17. The passage on p. 10 indicates that consumers pay bills electronically at a consumer terminal by initiating payment of a bill and the network routes the payment message to a biller terminal. The passage on p. 11 indicates that bills may also be paid electronically using the system even if they have not been previously presented.

Thus, the application supports the limitations of claim 26.

Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection to be reviewed on appeal are whether there is error in the rejection of Claims 1-21, 24-26, 31-32 and 34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5, 963,925 issued to Kolling et al. (Kolling) and whether there is error in the rejection of Claims 22, 23 and 33 as being unpatentable over Kolling in view of U.S. Patent 5,465,206 to Hilt et al (Hilt).

Argument

Section 102(b) (Claims 1-21, 24-26, 31-32 and 34)

Claims 1-21, 24-26, 31-32 and 34 are rejected as anticipated by published U.S. Patent 5, 963,925 issued to Kolling et al. (Kolling). The rejection states that Kolling discloses each of the limitations of Claims 1-21, 24-26, 31-32 and 34. Appellant appeals the rejection of the claims.

A claim is anticipated only if each and every limitation of the claim is found either expressly or inherently in a single prior art reference. Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1374 (Fed. Cir. 2001) (affirming invalidity of claims because of anticipation).

a. Claims 1-2, 4, 7, and 34

The system of independent claim 1 recites five specific limitations, several with qualifications and modifications. Claim 1 recites, *inter alia*, a switching system for electronic presentment and payment of bills over a network that includes a switching network that is a multi-standard switch configured to facilitate electronic communication between said first

consumer service provider or said second consumer terminal and said first bill service provider and said second biller terminal irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use.

Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system. Clearly a medium is not a message protocol. Kolling does not disclose at least a switching network that is a multi-standard switch that facilitates electronic communication between a consumer service provider or a consumer terminal and a bill service provider and a biller terminal irrespective of which message standard protocol each uses. The Kolling reference does not disclose, teach, or suggest a multi-standard switch which is configured to communicate using a plurality of different message standard protocols. Fig. 1 and 2 and col. 9, lines 1-24 of Kolling do not discuss, and thus do not disclose, any mention of using different message standard protocols.

Thus, the Kolling reference does not teach or suggest the multi-standard switching network as claimed by claim 1. Because the reference does not disclose at least this limitation of Claim 1, there is no anticipation of Claim 1, which is therefore allowable. Accordingly, the final rejection of Claim 1 is error. Claims 2, 4, 7, and 34 are allowable because they depend from Claim 1.

b. Claim 3

Claim 3 recites the electronic bill presentment and payment system of Claim 1, further comprising a second consumer service provider device which is in electronic communication

with a third consumer terminal, the switching network being in electronic communication with said second consumer service provider device using a different one of said first and second message standard protocols than the one of said first and second message protocols which is used between said first consumer service provider and said switching network.

Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system. The rejection cites col. 10, lines 55-65 and col. 9, lines 1-14 of Kolling. Col. 10, lines 55-65 teach that statement data can be received from any number of billers and is routed to any number of appropriate statement generation workstations located in different consumer financial institutions. Col. 9, lines 1-14 of Kolling teach that a consumer financial institution can deliver electronic statements to consumer using the consumer's medium of choice. Kolling does not teach a message protocol. Accordingly, there is error in the final rejection of Claim 3. Because the reference does not disclose at least this limitation of Claim 3, there is no anticipation of Claim 3, which is therefore allowable.

c. Claim 5

Claim 5 recites the electronic bill presentment and payment system of Claim 1 in which a second biller service device that is in electronic communication with a third consumer terminal with the switching network being in electronic communication with the second biller service provider device using a different message standard protocol than the message protocol which is being used between the first biller service provider and the switching network.

Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV,

personal digital assistants, or any other proprietary communication system. The rejection cites col. 10, lines 55-65 and col. 9, lines 1-14 of Kolling. Col. 10, lines 55-65 teach that statement data can be received from any number of billers and is routed to any number of appropriate statement generation workstations located in different consumer financial institutions. Col. 9, lines 1-14 of Kolling teach that a consumer financial institution can deliver electronic statements to consumer using the consumer's medium of choice. Kolling does not teach a message protocol.

Accordingly, there is error in the final rejection of Claim 5. Because the reference does not disclose at least this limitation of Claim 5, there is no anticipation of Claim 5, which is therefore allowable.

d. Claim 6

Claim 6 recites the electronic bill presentment and payment system of Claim 5 in which a biller payment provider device is in electronic communication between the first consumer service provider device and the switching network. A biller payment provider is defined in the specification as an individual, a company, or any other entity that receives and consolidates consumer payments on behalf of a biller and provides an electronic and/or paper for payment posting by the biller.

The rejection cites Biller Financial Institute element 108 (BFI) as being a biller payment provider. Kolling teaches at col. 7, lines 49-57 that a BFI may choose to collect consumer statements from a biller or from a biller service provider for forwarding to the electronic statement presentment system and that the term "biller" refers to any suitable organization that generates statements. There is no text or figure in Kolling depicting a BFI

that receives and consolidates consumer payments on behalf of a biller and provides an electronic and/or paper for payment posting by the biller.

Since Kolling does not teach or suggest the limitations of Claim 6, there is error in the rejection of Claim 6. Because the reference does not disclose at least this limitation of Claim 6, there is no anticipation of Claim 6, which is therefore allowable.

e. Claim 8

Claim 8 recites the electronic bill presentment and payment system of Claim 4, further comprising an associated memory device in which a directory of the first consumer service provider device, the first bill service provider device, the second consumer terminal, and the second biller terminal is stored, wherein the first consumer service provider device, the first bill service provider device, the second consumer terminal, and the second biller terminal must each be registered in the directory in order to access said switching network.

The rejection states that col. 33, lines 40-67 and elements 504 and 600 of FIGS. 6a and 8 of Kolling teaches the memory device in which the directory of the consumer service provider device, bill service provider device, consumer terminals, and biller terminals is stored and that the consumer service provider device, bill service provider device, consumer terminals, and biller terminals must each be registered in the directory. Col. 33, lines 40-67 of Kolling teach a computer system 800 in accordance with an embodiment of the Kolling invention. Kolling does not teach any directory in a memory device in which the directory of the consumer service provider, bill service provider, consumer terminals, and biller terminals is stored. Kolling teaches that a biller service provider, a consumer service provider, and a consumer enroll in the service. Kolling does not teach or suggest registering the devices/terminals of the biller service provider, the consumer service provider, the consumer,

or the biller. Accordingly, the rejection of Claim 8 is error. Because the reference does not disclose at least this limitation of Claim 8, there is no anticipation of Claim 8, which is therefore allowable.

f. Claims 9-13 and 15

Independent Claim 9 recites a switching system for electronic bill presentment and payment of bills over a network. The system of Claim 9 recites a consumer terminal, a biller terminal, and a switching network which is in electronic communication with the consumer terminal and the biller terminal and exchanging billing information between the consumer terminal and the biller terminal irrespective of which of a first message protocol or a second protocol each of the consumer terminal and the biller terminal use.

As noted above for Claim 1, Fig. 1 and 2 and col. 9, lines 1-24 of Kolling do not discuss, and thus do not disclose, any mention of using different message protocols. Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system. The Kolling reference does not disclose, teach, or suggest a switching network which is configured to communicate using a plurality of different message protocols.

Claim 9 further recites that the switching network route bill summary data generated by the biller terminal for presentment at the consumer terminal with complete bill data being accessible only by direct communications between the consumer terminal and the biller terminal.

The rejection states that Kolling teaches at col. 9, lines 1-24 and FIGS. 2 and 3 that complete bill data is accessible only by direct communications between the consumer terminal

and the biller terminal. FIGS. 2 and 3 of Kolling do not show any direct communication between the consumer terminal and the biller terminal. Col. 9, lines 1-24 of Kolling teach that an electronic statement generated at a statement generator workstation is transmitted to a consumer financial institution, which then delivers the statement to the consumer. It does not teach or suggest a direct communication between a consumer terminal and a biller terminal.

Accordingly, the rejection of Claim 9 is error. Because the reference does not disclose at least this limitation of Claim 9, there is no anticipation of Claim 9, which is therefore allowable. Claims 10-13 and 15 are allowable because they depend from Claim 9.

g. Claim 14

Claim 14 recites the electronic bill presentment and payment system of Claim 13 in which a biller payment provider device is in electronic communication between the biller service provider device and the switching network. A biller payment provider is defined in the specification as an individual, a company, or any other entity that receives and consolidates consumer payments on behalf of a biller and provides an electronic and/or paper for payment posting by the biller.

The rejection states that claim 14 recites similar limitations to claim 6 and thus rejected using the same art and rationale in the rejection of claim 6. Claim 14 depends from dependent claim 13, which depends from independent claim 9 while claim 6 depends from dependent claim 5, which depends from independent claim 1. A dependent claim requires all of the elements of its independent claim and any intervening claims. Since independent claims 1 and 9 have different claim limitations, it necessarily follows that claim 14 cannot be rejected for with the same rationale as claim 6.

Furthermore, assuming *arguendo* that the rejection of claim 14 uses the same rejection of claim 6, claim 6 cites Biller Financial Institute element 108 (BFI) as being a biller payment provider. Kolling teaches at col. 7, lines 49-57 that a BFI may choose to collect consumer statements from a biller or from a biller service provider for forwarding to the electronic statement presentment system and that the term "biller" refers to any suitable organization that generates statements. There is no text or figure in Kolling depicting a BFI that receives and consolidates consumer payments on behalf of a biller and provides an electronic and/or paper for payment posting by the biller.

Since Kolling does not teach or suggest the limitations of Claim 9, there is error in the rejection of Claim 9. Because the reference does not disclose at least this limitation of Claim 9, there is no anticipation of Claim 9, which is therefore allowable.

h. Claim 16

Claim 16 recites the electronic bill presentment and payment system of Claim 12, further comprising an associated memory device in which a directory of the consumer terminal and the biller terminal is stored, wherein the consumer terminal and the biller terminal must each be registered in the directory in order to access the switching network.

The rejection states that claim 16 recites similar limitations to claim 8 and thus rejected using the same art and rationale in the rejection of claim 8. Claim 16 depends from dependent claim 12, which depends from independent claim 9 while claim 8 depends from dependent claim 4, which depends from independent claim 1. A dependent claim requires all of the elements of its independent claim and any intervening claims. Since independent claims 1 and 9 have different claim limitations, it necessarily follows that claim 16 cannot be rejected for with the same rationale as claim 8.

Furthermore, assuming *arguendo* that the rejection of claim 16 uses the same rejection of claim 8, the rejection of claim 8 states that col. 33, lines 40-67 and elements 504 and 600 of FIGS. 6a and 8 of Kolling teaches the memory device in which the directory of the consumer service provider device, bill service provider device, consumer terminals, and biller terminals is stored and that the consumer service provider device, bill service provider device, consumer terminals, and biller terminals must each be registered in the directory. Col. 33, lines 40-67 of Kolling teach a computer system 800 in accordance with an embodiment of the Kolling invention. Kolling does not teach any directory in a memory device in which the directory of the consumer service provider, bill service provider, consumer terminals, and biller terminals is stored. Kolling teaches that a biller service provider, a consumer service provider, and a consumer enroll in the service. Kolling does not teach or suggest registering the devices/terminals of the biller service provider, the consumer service provider, the consumer, or the biller.

Accordingly, the rejection of Claim 16 is error. Because the reference does not disclose at least this limitation of Claim 16, there is no anticipation of Claim 16, which is therefore allowable.

i. Claims 17-19 and 24

Independent claim 17 recites a method for electronic bill presentment and payment of bills over a network. The method recites, *inter alia*, providing a switching network that includes a switching network that is a multi-standard switch configured to communicate with first and second biller terminals and first and second consumer terminals in either of at least first and second message standard protocols, the switching network communicating with at least one of the first and second biller terminals and the first and second consumer terminals using the first message standard protocol and at least one of the first and second biller

terminals and the first and second consumer terminals using the second message standard protocol.

The rejection states that FIGS. 1 and 2, col. 10, lines 55-65 and col. 9, lines 1-14 of Kolling teach the above limitations of claim 17. As noted above for Claim 1, Fig. 1 and 2 and col. 9, lines 1-24 of Kolling do not discuss, and thus do not disclose, any mention of using different message protocols. Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system. The Kolling reference does not disclose, teach, or suggest a switching network which is configured to communicate using different message protocols.

Claim 17 further requires generating bill summary data from complete bill data provided by each of the first and second billing terminals and selectively routing portions of the bill summary data to the first and second consumer billing terminals.

The rejection states that Kolling can display summary invoice as well as the whole invoice in any format chosen by the consumer and refers to col. 31, lines 57-67 and the abstract of Kolling. Col. 31, lines 57-67 of Kolling refer to FIGS. 13-15. Col. 31 refers to FIGS. 11-16, which are screen shots from an Internet site illustrating an electronic banking World Wide Web application that includes the ability for electronic statement presentment. The Internet site is indicated as one medium by which a consumer financial institution or consumer service provider communicates with its customers and delivers an electronic statement. The screen shots are a welcome screen, a sample list of invoices screen, a sample invoice summary screen, a sample invoice detail screen, a sample enclosure screen, and a sample make payment screen. Clicking on an invoice on the sample list of invoice screen takes a consumer to an invoice summary screen such as the sample invoice summary screen.

Clicking on a detail button on the invoice summary screen takes the consumer to an invoice detail screen that provides further details on the invoice. It can be seen that Kolling delivers an entire invoice to a consumer and populates various screens with data from the invoice. Kolling does not teach or suggest selectively routing portions of the bill summary data to the first and second consumer billing terminals.

Accordingly, the rejection of Claim 17 is error. Because the reference does not disclose at least this limitation of Claim 17, there is no anticipation of Claim 17, which is therefore allowable. Claims 18-19 and 24 are allowable because they depend from Claim 17.

j. Claim 20

Claim 20 depends from claim 17 and further recites accessing complete bill data for a particular bill only by communicating directly between the one of the first and second consumer terminals seeking the complete bill data for the particular bill and the one of the first and second biller terminals having complete bill data for the particular bill.

The figures of Kolling do not show any direct communication between a consumer terminal and a biller terminal. Kolling teaches that an electronic statement generated at a statement generator workstation is transmitted to a consumer financial institution, which then delivers the statement to the consumer. It does not teach or suggest a direct communication between a consumer terminal and a biller terminal.

Accordingly, the rejection of Claim 20 is error. Because the reference does not disclose at least this limitation of Claim 20, there is no anticipation of Claim 20, which is therefore allowable.

k. Claim 21

Claim 21 depends from claim 17 and further recites storing a directory of consumer terminals which are registered with the switching network in an associated memory device, generating payment instructions from the first and second consumer terminals, transmitting the payment instructions which are generated by the first and second consumer terminals to the switching network, verifying that the payment instructions are from consumer terminals which are registered with the switching network, and causing the payment instructions to be executed if the payment instructions are from consumer terminals which are registered with the switching network.

The rejection states that col. 33, lines 40-67 of Kolling teach storing a directory of consumer terminals which are registered with the switching network in an associated memory device; that col. 13, lines 52-58 teach generating payment instructions from the first and second consumer terminals and transmitting the payment instructions which are generated by the first and second consumer terminals to the switching network; and that consumers are presented with a login prompt (FIG. 11 of Kolling) which allows only customers who are registered with the switching network to gain access to the switching network and that it is inherent that payment instructions made by the consumers from the consumer terminals are verified.

Col. 33, lines 40-67 of Kolling teach a computer system 800 in accordance with an embodiment of the Kolling invention. Kolling does not teach any directory in a memory device in which the directory of the consumer service provider, bill service provider, consumer terminals, and biller terminals is stored. Kolling teaches that a consumer enrolls in the service. Kolling does not teach or suggest storing a directory of consumer terminals which are registered with the switching network in an associated memory device.

In finding inherent anticipation, a limitation missing from an explicit disclosure is inherent if that missing limitation or characteristic is necessarily present, or inherent, in the single anticipating reference. Continental Can. Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (vacating summary judgment of anticipation because of insufficient evidence). It is not inherent that a verification is made that a consumer terminal is registered with a switching network when a consumer gains access to the switching network via a login prompt. For example, a consumer could log onto a network via a login prompt using a public computer such as in a library without the public computer necessarily being registered with the network. Furthermore, whether or not it is inherent that payment instructions made by the consumers from the consumer terminals are verified has nothing to do with verifying that the payment instructions are from consumer terminals that are registered with the switching network.

Accordingly, the rejection of Claim 21 is error. Because the reference does not disclose at least this limitation of Claim 21, there is no anticipation of Claim 21, which is therefore allowable.

I. Claim 25

Independent Claim 25 recites, *inter alia*, that the switching network be a multi-standard switch configured to communicate with first and second consumer terminals and first and second biller terminals where the switching network communicates with at least one of the first and second consumer terminals and first and second biller terminals using a first message standard protocol and at least one of the first and second consumer terminals and first and second biller terminals using a second message standard protocol.

Kolling discloses a medium in which electronic statements can be delivered. Kolling teaches that a medium can be the Internet, telephones, video telephones, televisions, WebTV, personal digital assistants, or any other proprietary communication system. Clearly a medium is not a message protocol. Kolling does not disclose at least a switching network that is a multi-standard switch that communicates with at least one of the first and second consumer terminals and first and second biller terminals using a first message standard protocol and at least one of the first and second consumer terminals and first and second biller terminals using a second message standard protocol.

Accordingly, the rejection of Claim 25 is error. Because the reference does not disclose at least this limitation of Claim 25, there is no anticipation of Claim 25, which is therefore allowable.

m. Claim 26

Independent claim 26 recites a system for electronic presentment and payment of bills over a network including a switching network for routing a payment message for a particular bill between a consumer terminal and a biller terminal irrespective of whether the particular bill has been previously presented to the consumer terminal.

The rejection states that col. 9, lines 1-24 and col. 19, lines 15-20 of Kolling teach these limitations. Col. 9, lines 1-24 of Kolling teach that a consumer makes a payment after receiving an electronic statement. Col. 19, lines 15-20 of Kolling teach that an exemplary electronic statement includes a mandatory section automatically presented to a consumer and optional sections that are downloaded and presented only at the consumer request. Kolling does not teach or suggest routing a payment message irrespective of whether the particular bill has been previously presented to the consumer terminal.

Accordingly, the rejection of Claim 26 is error. Because the reference does not disclose at least this limitation of Claim 26, there is no anticipation of Claim 26, which is therefore allowable.

n. Claim 31

Claim 31 depends from claim 1 and recites that the first message standard protocol comprises the Open Financial Exchange ("OFX") standard protocol and the second message standard protocol comprises the Interactive Financial Exchange ("IFX") standard protocol.

Kolling teaches that the system is compatible with the OFX standard protocol. Kolling does not teach or suggest the IFX standard protocol.

Accordingly, the rejection of Claim 31 is error. Because the reference does not disclose all of the limitations of Claim 31, there is no anticipation of Claim 31, which is therefore allowable.

o. Claim 32

Claim 32 depends from claim 1 and recites, *inter alia*, that complete bill data be accessible only by direct communications between the first or second consumer terminals and the biller service provider device or the first or second biller terminals.

Kolling does not show any direct communications between consumer terminals and biller terminals or a biller service provider device. Kolling teaches that an electronic statement generated at a statement generator workstation is transmitted to a consumer financial institution, which then delivers the statement to the consumer. It does not teach or suggest a direct communication between a consumer terminal and a biller terminal or a biller service provider device.

Accordingly, the rejection of Claim 32 is error. Because the reference does not disclose all of the limitations of Claim 32, there is no anticipation of Claim 32, which is therefore allowable.

Section 103(a) (Claims 22, 23 and 33)

Claims 22, 23 and 33 are rejected as being unpatentable over U.S. Patent 5,963,925 issued to Kolling et al. (Kolling) in view of U.S. Patent 5,465,206 issued to Hilt et al. (Hilt). Appellant appeals the rejection of the claims.

To establish a prima facie case of obviousness, a showing of three basic criteria is required. First, there must be some reason, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine teachings. For the claimed invention to be obvious, there must be some teaching, suggestion, or incentive in the art to make the combination made by the inventor. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990); *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). It is not necessary, however, that there be an explicit suggestion in one or more references to make the claimed combination. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025 (Fed. Cir. 1985); *In re Oetiker*, 977 F.2d 1443, 1448 (Fed. Cir. 1992) (Nies, C.J., concurring); *Ex Parte Anderson*, 30 USPQ2d 1866, 1868 (Bd. Pat. App. & Inter. 1994). Rather, claims are obvious if there was knowledge generally available to one of ordinary skill in the relevant art that leads one to combine the relevant teachings of the various prior art references. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n.24 (Fed. Cir. 1985). Stated differently, the claimed invention is obvious if the inventor applied knowledge clearly present in the prior art. *In re Sernaker*, 702 F.2d 989, 995 (Fed. Cir. 1983). The teaching or suggestion to make

the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Any proposed modification cannot render the prior art unsatisfactory for its intended purpose (see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)) or change the principle of operation of a reference. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. See M.P.E.P. 2143. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

a. Claim 22

Claim 22 depends from claim 21, which depends from claim 17, and further requires that the switching network verifies that a sufficient balance exists in a financial account associated with each consumer terminal from which payment instructions are received to cover the bill being paid. The switching network is defined in claim 17 as being a multi-standard switch configured to communicate with first and second biller terminals and first and second consumer terminals.

As indicated previously, Kolling does not disclose or suggest providing a switching network that includes a switching network that is a multi-standard switch configured to

communicate with first and second biller terminals and first and second consumer terminals in either of at least first and second message standard protocols, the switching network communicating with at least one of the first and second biller terminals and the first and second consumer terminals using the first message standard protocol and at least one of the first and second biller terminals and the first and second consumer terminals using the second message standard protocol. Nor does Kolling teach or suggest storing a directory of consumer terminals which are registered with the switching network in an associated memory device, generating payment instructions from the first and second consumer terminals, transmitting the payment instructions which are generated by the first and second consumer terminals to the switching network, verifying that the payment instructions are from consumer terminals which are registered with the switching network, and causing the payment instructions to be executed if the payment instructions are from consumer terminals which are registered with the switching network. No teaching or suggestion could be found in Hilt of the preceding limitations. Therefore, neither Kolling nor Hilt teaches or suggests, singly or in combination, all of the elements of claim 22.

The rejection states Kolling does not disclose the method of claim 22 and that the abstract and figure 11, element 254 of Hilt teaches the limitations of claim 22. The abstract of Hilt teaches that the consumer's bank does not submit the transaction until funds are good unless the consumer's bank is willing to take the risk of loss if funds are not good. Hilt indicates at col. 21, lines 7-21 that element 254 in figure 11, which is a block that checks if funds are available, is done by a bank (bank C). Clearly, a bank is not a switching network.

Accordingly, the rejection of Claim 22 is error. Because the reference does not disclose all of the limitations of Claim 22, there is no anticipation of Claim 22, which is therefore allowable.

b. Claim 23

Claim 23 depends from claim 22 and recites the step of settling all payment transactions over a predetermined cut-off period.

The rejection states Kolling does not disclose the method of claim 23 and that the abstract and figure 11 of Hilt teaches the limitations of claim 23. The abstract of Hilt does not disclose or even suggest settling all payment transactions over a predetermined cut-off period. The abstract discloses how a consumer authorizes a remittance and the steps the consumer's bank and the biller's bank takes in rendering payment to the biller. The corresponding text in Hilt to FIG. 11 at col. 21, line 36 to col. 22, line 1 describes the process in which a consumer receives a bill and sends a bill pay order to the consumer's bank and the process in which the consumer's bank, the biller's bank, and the biller debits the consumer's account and credits the biller's account. There is no teaching or suggestion of settling all payment transaction over a predetermined cut-off period.

Accordingly, the rejection of Claim 23 is error. Because the reference does not disclose all of the limitations of Claim 23, there is no anticipation of Claim 23, which is therefore allowable.

c. Claim 33

Claim 33 depends from claim 1 and recites that the switching network is arranged and configured to provide net settlement functionality by debiting financial accounts associated with consumers associated with the first and second consumer terminals and crediting the financial accounts of billers associated with the first and second biller terminals by appropriate amounts.

As previously indicated, Kolling does not disclose at least a switching network that is a multi-standard switch that facilitates electronic communication between a consumer service provider or a consumer terminal and a bill service provider and a biller terminal irrespective of which message standard protocol each uses. Nor does the Kolling reference teach or suggest a multi-standard switch which is configured to communicate with devices using different message standard protocols. No teaching or suggestion could be found in Hilt of the preceding limitations. Therefore, neither Kolling nor Hilt teaches or suggests, singly or in combination, all of the elements of claim 22.

Accordingly, the rejection of Claim 23 is error. Because the reference does not disclose all of the limitations of Claim 23, there is no anticipation of Claim 23, which is therefore allowable.

Appellant has shown that the rejection of rejection of Claims 1-21, 24-26, 31-32 and 34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5, 963,925 and the rejection of Claims 22, 23 and 33 as being unpatentable over U.S. Patent 5, 963,925 in view of U.S. Patent 5,465,206 is error. Appellant and the attorney below earnestly request that the Board reverse the rejections of Claim 1-20 and allow the claims of the application.

/Kevin L. Wingate/
Kevin L. Wingate, Reg. No. 38662
REINHART BOERNER VAN DEUREN P.C.
2215 Perrygreen Way
Rockford, Illinois 61107
(815) 633-5300 (telephone)
(815) 654-5770 (facsimile)

Date: July 16, 2007

CLAIMS APPENDIX

1. (Previously Presented) A switching system for electronic presentment and payment of bills over a network, comprising:

a first consumer service provider device which is in electronic communication with a first consumer terminal;

a first biller service provider device which is in electronic communication with a first biller terminal;

a second consumer terminal;

a second biller terminal; and

a switching network which is in electronic communication with said first consumer service provider device using one of a first message standard protocol and a second message standard protocol, with said first bill service provider device using one of said first and second message standard protocols, with said second consumer terminal using one of said first and second message standard protocols, and with said second biller terminal using one of said first and second message standard protocols, routing presentment information between said first consumer service provider or said second consumer terminal and said first bill service provider or said second biller terminal, said switching network being a multi-standard switch configured to facilitate electronic communication between said first consumer service provider or said second consumer terminal and said first bill service provider and said second biller terminal irrespective of which message standard protocol each of said first consumer service provider, said first bill service provider, said second consumer terminal, and said second biller terminal use.

2. (Previously Presented) A switching system as defined in Claim 1, wherein said switching network routes information between said consumer service provider or said second consumer terminal and said bill service provider or said second biller terminal without reformatting.

3. (Previously Presented) A switching system as defined in Claim 1, further comprising a second consumer service provider device which is in electronic communication with a third consumer terminal, said switching network being in electronic communication with said second consumer service provider device using a different one of said first and second message standard protocols than the one of said first and second message protocols which is used between said first consumer service provider and said switching network.

4. (Previously Presented) A switching system as defined in Claim 1, further comprising a consumer payment provider device in electronic communication between said first consumer service provider device and said switching network.

5. (Previously Presented) A switching system as defined in Claim 1, further comprising a second biller service provider device which is in electronic communication with a third consumer terminal, said switching network being in electronic communication with said second biller service provider device using a different one of said first and second message standard protocols than the one of said first and second message protocols which is used between said first biller service provider and said switching network.

6. (Previously Presented) A switching system as defined in Claim 5, further comprising a biller payment provider device in electronic communication between said first consumer service provider device and said switching network.

7. (Previously Presented) A switching system as defined in Claim 6, further comprising a payee terminal in electronic communication with said biller payment provider device.

8. (Previously Presented) A switching system as defined in Claim 4, further comprising an associated memory device in which a directory of said first consumer service provider device, said first bill service provider device, said second consumer terminal, and said second biller terminal is stored, wherein said first consumer service provider device, said first bill service provider device, said second consumer terminal, and said second biller terminal must each be registered in said directory in order to access said switching network.

9. (Previously Presented) A switching system for electronic presentment and payment of bills over a network, comprising:

a consumer terminal;

a biller terminal; and

a switching network which is in electronic communication with said consumer terminal using one of a first message standard protocol and a second message standard protocol and with said biller terminal using one of said first and second message protocols, exchanging billing information between said consumer terminal and said biller terminal

irrespective of which message protocol each of said consumer terminal and said biller terminal use, said switching network routing bill summary data generated by said biller terminal for presentment at said consumer terminal, complete bill data being accessible only by direct communications between said consumer terminal and said biller terminal.

10. (Previously Presented) A switching system as defined in Claim 9, wherein said switching network routes information between said consumer terminal and said biller terminal without reformatting.

11. (Previously Presented) A switching system as defined in Claim 9, further comprising a consumer service provider device in electronic communication between said consumer terminal and said switching network.

12. (Previously Presented) A switching system as defined in Claim 11, further comprising a consumer payment provider device in electronic communication between said consumer service provider device and said switching network.

13. (Previously Presented) A switching system as defined in Claim 9, further comprising a biller service provider device in electronic communication between said biller terminal and said switching network.

14. (Previously Presented) A switching system as defined in Claim 13, further comprising a biller payment provider device in electronic communication between said biller service provider device and said switching network.

15. (Previously Presented) A switching system as defined in Claim 14, further comprising a payee terminal in electronic communication with said biller payment provider device.

16. (Previously Presented) A switching system as defined in Claim 12, further comprising an associated memory device in which a directory of said consumer terminal and said biller terminal is stored, wherein said consumer terminal and said biller terminal must each be registered in said directory in order to access said switching network.

17. (Previously Presented) A method for electronic presentment and payment of bills over a network, comprising:

providing a switching network for facilitating electronic presentment and payment of bills;

establishing electronic communication between said switching network and first and second biller terminals and first and second consumer terminals, said switching network being a multi-standard switch configured to communicate with said first and second biller terminals and said first and second consumer terminals in either of at least first and second message standard protocols, said switching network communicating with at least one of said first and second biller terminals and said first and second consumer terminals using said first message standard protocol and at least one of said first and second biller terminals and said first and second consumer terminals using said second message standard protocol;

generating bill summary data from complete bill data provided by each of said first and second billing terminals;

selectively routing portions of said bill summary data via the switching network to present appropriate portions of said bill summary data to said first and second consumer billing terminals.

18. (Previously Presented) A method as defined in Claim 17, wherein electronic communication between said switching network and said first consumer terminal is established through a first consumer service provider device, and wherein electronic communication between said switching network and said second consumer terminal is established through a second consumer service provider device.

19. (Previously Presented) A method as defined in Claim 17, wherein said routed bill summary data is not reformatted by said switching network.

20. (Previously Presented) A method as defined in Claim 17, further comprising accessing complete bill data for a particular bill only by communicating directly between the one of said first and second consumer terminals seeking said complete bill data for said particular bill and the one of said first and second biller terminals having complete bill data for said particular bill.

21. (Previously Presented) A method as defined in Claim 17, further comprising the steps of:

storing a directory of consumer terminals which are registered with said switching network in an associated memory device;
generating payment instructions from said first and second consumer terminals;
transmitting said payment instructions which are generated by said first and second consumer terminals to said switching network;
verifying that said payment instructions are from consumer-terminals which are registered with said switching network; and
if said payment instructions are from consumer terminals which are registered with said switching network, causing said payment instructions to be executed.

22. (Previously Presented) A method as defined in Claim 21, wherein prior to said step of causing said payment instructions to be executed said switching network verifies that a sufficient balance exists in a financial account associated with each consumer terminal from which payment instructions are received to cover the bill being paid.

23. (Previously Presented) A method as defined in Claim 22, further comprising the step of settling all payment transactions over a predetermined cut-off period.

24. (Previously Presented) A method as defined in Claim 17, wherein said wherein electronic communication between said switching network and said first biller terminal is established through a first biller service provider device, and wherein electronic communication between said switching network and said second biller terminal is established through a second biller service provider device.

25. (Previously Presented) A switching system for electronic presentment and payment of bills over a network, comprising:
a first consumer terminal;
a second consumer terminal;
a first biller terminal;
a second biller terminal; and
a switching network in electronic communication with said first and second consumer terminals and said first and second biller terminals, said switching network for routing presentment information from said first and second biller terminals to said first and second consumer terminals and payment information from said first and second consumer terminals and said first and second biller terminals, said switching network being a multi-standard

switch configured to communicate with said first and second consumer terminals and said first and second biller terminals in either of first and second message standard protocols, said switching network communicating with at least one of said first and second consumer terminals and said first and second biller terminals using said first message standard protocol and at least one of said first and second consumer terminals and said first and second biller terminals using said second message standard protocol.

26. (Original) A system for electronic presentment and payment of bills over a network, comprising:

- a consumer terminal;
- a biller terminal in communication with said consumer terminal; and
- a switching network for routing a payment message for a particular bill between said consumer terminal and biller terminal, irrespective of whether the particular bill has been previously presented to said consumer terminal.

27. – 30. (Cancelled)

31. (Previously Presented) A switching system as defined in Claim 1, wherein said first message standard protocol comprises the Open Financial Exchange ("OFX") standard protocol and said second message standard protocol comprises the Interactive Financial Exchange ("IFX") standard protocol.

32. (Previously Presented) A switching system as defined in Claim 1, wherein said switching network routes bill summary data generated by said biller service provider device or by said first or second biller terminals for presentment at said first or second consumer terminals, complete bill data being accessible only by direct communications between said first or second consumer terminals and said biller service provider device or said first or second biller terminals.

33. (Previously Presented) A switching system as defined in Claim 1, wherein said switching network is arranged and configured to provide net settlement functionality by debiting financial accounts associated with consumers associated with said first and second consumer terminals and crediting the financial accounts of billers associated with said first and second biller terminals by appropriate amounts.

34. (Previously Presented) A switching system as defined in Claim 1, wherein said switching network is arranged and configured to log all presentment and payment communications as they are routed for reporting on a periodic basis.

Application No. 09/751,265
Notice of Appeal filed July 12, 2007
Appeal Brief filed July 16, 2007

EVIDENCE APPENDIX

None

Application No. 09/751,265
Notice of Appeal filed July 12, 2007
Appeal Brief filed July 16, 2007

RELATED PROCEEDINGS APPENDIX

None